Application Number 09/876,432
Responsive to Office Action mailed August 10, 2006

REMARKS

This amendment is responsive to the Office Action dated August 10, 2006. Applicant has amended claims 1, 8, 15, 18, 21, 22, 41, 42, 45, 75, 76, 83, 84, 91, 95, 101, and 102, and canceled claims 14 and 79. Claims 1, 3–8, 10–13, 15–24, 39–49, and 75–102 are pending.

As a preliminary matter, the Examiner objected to claims 41–47 because of certain informalities. Applicant has amended claims 41, 42, and 45 by way of a non-narrowing amendment for purposes of clarification.

Claim Rejection Under 35 U.S.C. § 103

Claims 1, 3–8, 10–25, 75–94

In the Office Action, the Examiner rejected claims 1, 3–8, 12–16, 18–23, 75–84 and 87–94 under 35 U.S.C. 103(a) as being unpatentable over Davidsson (US 6,934,718) in view of Garber et al. (US 6,232,870) ("Garber"). Applicant respectfully traverses the rejection to the extent such rejections may be considered applicable to the claims as amended. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

For example, independent claims 1, 8, 18, 75, 91, as amended, require that the step of using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information is performed after selecting a category of items using a user interface associated with an RFID reader. That is, claims 1, 8, 18, 75, 91 require that a category of items is selected prior to interrogation of the RFID tag(s) from which information is obtained.

Davidsson describes a web browser configured to categorize book-marked web pages. In contrast to the requirements of claims 1, 8, 18, 75, 91, Davidsson teaches that the web page is obtained prior to the user selecting one or more categories for the web page. In particular, Davidsson states that "web page A is displayed in window 38, ready to be bookmarked."[1] Neither Davidsson not Garber, alone or in combination, teaches or suggests selecting a category of items using a user interface associated with an RFID reader, and after selecting the category,

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[1] Davidsson, col. 5, ll. 38–39.

-14-

using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, wherein the item of interest is not currently associated with the selected category, and thereafter associating the obtained information with the selected category.

As another example, amended independent claim 8 requires using the RFID reader to automatically categorize the information obtained in step (b) with at least one of the categories selected in step (a), and wherein information necessary to categorize each RFID-tagged item may be obtained from the RFID tag itself. Davidsson provides no teaching or suggestion that the web browser automatically categorizes web pages using information obtained from the web pages themselves. Rather, the user must interact with the web browser and manually select the categories that the user wishes to associate with particular web pages. Therefore, even when combined, Davidsson in view of Garber provides no RFID device capable of automatically categorizing information received from an RFID-tagged item within multiple (at least two) pre-selected categories.

Similarly, amended independent claim 18 requires using the RFID reader to categorize information and ignore any RFID-tagged-item that may not be categorized in any of the categories, wherein the **RFID reader** determines which of the RFID-tagged-items may not be categories in any of the categories.. The Examiner states that Davidsson teaches that the user may bookmark a web page without selecting a category with which to categorize the web page. However, unlike the features recited by claim 18, in the Davidsson system the user makes the decision not to categorize the web page. Applicant also submits that bookmarking a web page without an associated category does not teach or suggest ignoring any RFID-tagged-item that may not be categorized in any category. In particular, the Davidsson system does not "ignore" the uncategorized web page, because an affirmative action is taken by bookmarking the web page, and data relating to the web page is stored in the process of bookmarking the web page. Consequently, Davidsson provides no teaching pertinent to using an RFID reader to categorize information, and using the RFID reader to ignore any RFID-tagged-item that may not be categorized in any of the categories, wherein in step (d) the RFID reader determines which of the RFID-tagged-items may not be categories in any of the categories, as recited by independent claim 18.

-15-

Application Number 09/876,432
Responsive to Office Action mailed August 10, 2006

Similarly, amended independent claim 76 requires selecting a category of items using a user interface associated with a computer, and designating one or more attributes of items in that category to define the category, obtaining a list of at least one RFID-tagged item, and automatically associating information related to the at least one item with the selected category using the designated attributes, wherein the information is obtained by interrogating the RFID tag associated with the at least one item. As explained above, Davidsson provides no teaching or suggestion of automatically categorizing web pages. Moreover, Davidsson fails to teach or suggest automatically associating information related to the at least one item with the selected category using the designated attributes, wherein the information is obtained by interrogating the RFID tag associated with the at least one item, as further required by claim 76.

As a further example, amended independent claim 83 requires, as a primary operation, categorizing information related to the at least one item(s) associated with the interrogated RFID tag(s) in at least one of the categories, wherein the information is obtained by interrogating the RFID tag(s). Claim 83 also requires, simultaneously with the primary operation of categorizing information in step (c), using the information obtained by the interrogation for performing a background inventory operation of determining the presence or absence of the items in the storage area and updating an inventory database to reflect the determined presence or absence of the items in the storage area. Neither Davidsson nor Garber, alone or in combination, teaches or suggests this feature.

In the Office Action, the Examiner acknowledged that Davidsson fails to provide any teaching or suggestion pertinent to using an RFID reader to interrogate RFID tags associated with items. In view of this basic deficiency in the teachings of Davidsson, the Examiner cited Garber as teaching using a portable RFID device with a group of items each having an RFID tag. The Examiner concluded that it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to modify the system described by Davidsson to include the RFID reader of Garber to "expand the useful[ness] of Davidsson in a library environment using an RFID tag because it is easier and faster for the user to retrieve or find books, periodicals, and magnetic and optical media when they are categorized."[2] Applicant respectfully disagrees with this conclusion.

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[2] Office Action dated August 10, 2006, at page 7.

-16-

First, it is unclear how such a modification would even be carried out. For example, how could an RFID reader be incorporated into a web browser that categorizes web pages to categorize the information obtained by interrogating RFID tags with the RFID reader? Moreover, how could Davidsson's teaching of a web browser's use of marker signal flags that are collocated with a URL of a web page and thumbnail data for the web page be applied to using an RFID reader to categorize information obtained by interrogating RFID tags? Second, even if such a modification were somehow made, it would not result in Applicant's claims, due to the many other deficiencies of Davidsson as described above.

Third, the Examiner has identified no teaching in the prior art of a motivation to combine the teaching of the applied references. Specifically, the Examiner has identified no motivation found within the prior art that teaches the modification of the web browser of Davidsson using the RFID system of Garber. The Examiner has failed to explain why one of ordinary skill in the art would have looked to the RFID system of Garber for modification of the web browser of Davidsson for categorizing web pages.

The Court of Appeals for the Federal Circuit has made clear that motivation to combine references must be found in the prior art, and that it is impermissible hindsight for the Examiner to use the motivation stated in Applicant's own disclosure as a blueprint to reconstruct the claimed invention from the prior art.[3] It is improper to point to teachings of motivation contained within Applicants' own disclosure.[4] Moreover, it is insufficient to merely pull such motivation out of thin air. Rather, the Examiner's rejection must be based on substantial evidence in the record demonstrating that the motivation for making the claimed invention resides in the prior art.[5]

In summary, the Examiner's conclusion of obviousness, and particularly the cited motivation to modify Davidsson in view of Garber, is unsupported by any substantial evidence in the record.

The Examiner also rejected claims 10, 11, 85 and 86 under 35 U.S.C. 103(a) as being unpatentable over Davidsson in view of Garber et al. as applied to claims 8 and 83 above, and

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[3] *See Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (CAFC 1985); *see also In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988); *see also In re Gorman*, 18 USPQ 2d 1885, 1888 (CAFC 1991); *see also Al-Site Corp. v. VSI International, Inc.*, 50 USPQ2d 1161, 1171 (CAFC 1999).
[4] *In re Oetiker*, 24 USPQ2d at 1445.

-17-

further in view of Beauchamp (US 6,886,011). Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention. Claims 10, 11, 85 and 86 are patentable for the same reasons stated above for independent claims 1 and 83, respectively; namely, because the Davidsson reference lacks the basic teachings attributed to it by the Examiner, and because one skilled in the art would have had no motivation to look from Davidsson to Garber for any modifications. Moreover, Beauchamp provides no teaching sufficient to cure the basic deficiencies already evident in Davidsson and Garber.

The Examiner also rejected claims 17 and 24 under 35 U.S.C. 103(a) as being unpatentable over Davidsson in view of Garber et al. as applied to claim 16 above, and further in view of Parulski et al. (US 5,633,678). Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention. Claims 17 and 24 are patentable for the same reasons stated above for independent claims 1 and 18, respectively; namely, because the Davidsson reference lacks the basic teachings attributed to it by the Examiner, and because one skilled in the art would have had no motivation to look from Davidsson to Garber for any modifications. Moreover, Parulski et al. provides no teaching sufficient to cure the basic deficiencies already evident in Davidsson and Garber.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 1, 3–8, 10–25, 75–94 under 35 U.S.C. 103(a). Withdrawal of this rejection is requested.

Claims 39–42, 45, 48 and 95–102

In the Office Action, the Examiner rejected claims 39–42, 45, 48 and 95–101 under 35 U.S.C. 103(a) as being unpatentable over Garber in view of Barritz et al. (US 2002/0008621) ("Barritz"). Applicant respectfully traverses the rejection to the extent such rejections may be considered applicable to the claims as amended. The applied references fail to disclose or

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[3] *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002); *In re Chu*, 36 USPQ2d at 1094.

-18-

suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

Claims 39-41

For example, independent claim 39 requires interrogating RFID tags, using the information obtained in the interrogation step for performing a primary operation of determining whether the items are in a predetermined order within a physical storage area, and simultaneously with the primary operation of determining whether the items are in a predetermined order within the storage area in step (b), using the information obtained by the interrogation in step (a) for performing a background inventory operation of determining the presence or absence of the items in the storage area and updating an inventory database to reflect the determined presence or absence of the items in the storage area. Independent claims 40 and 41 recite similar limitations, with the primary operation of claim 40 being searching for certain items on a predetermined search list, and the primary operation of claim 42 being checking items into or out of a physical storage area. Garber in view of Barritz fails to teach or suggest using information obtained by interrogating RFID tags for the primary operations recited above, while simultaneously using the same information obtained in step (a) for performing the background inventory operation.

In the Office Action, the Examiner stated that Garber discloses indicating when interrogated items are not in the correct order, and further discloses checking out library materials by interrogating RFID tags. The Examiner acknowledged that Garber fails to teach determining the presence or absence of the items and updating the inventory database to reflect the determined presence or absence. The Examiner stated that it would have been obvious to combine the RFID system of Garber with the teachings of Barritz for using a barcode scanner to verify scanned codes against a database of known inventory items. However, neither Garber nor Barritz teaches or suggests performing any of the primary operations recited by claims 39-41 simultaneously with performing a background inventory operation of determining the presence or absence of the items in the physical storage area to update an inventory database to reflect the determined presence or absence of the items in the physical storage area. Moreover, neither Garber nor Barritz teaches or suggests using the same information for performing the background inventory operation as was obtained for performing the primary operation.

-19-

Application Number 09/876,432
Responsive to Office Action mailed August 10, 2006

Even if one of ordinary skill were to combine the teachings of Barritz with the RFID system of Garber, such combination would at most result in an RFID system that was capable of interrogating RFID tags for performing the primary operation, as well as interrogating RFID tags for performing the inventory operation. However, such a system would still require the tags to be interrogated for each separate operation, and run the primary operation and the inventory operation in sequence and not simultaneously. In contrast, claims 39–41 disclose performing the primary operation simultaneously with performing a background inventory operation using the same information that was obtained for performing the primary operation. Garber and Barritz provide no teaching or suggestion of such features. In the absence of any such teaching in the prior art references, Applicant's claims 39–41 should be allowed.

Claims 42 and 45

With respect to independent claims 42 and 45, the Examiner appears to have some confusion over the scope of these claims. In the Office Action, the Examiner stated: "For examination purposes, the Examiner will assume that the item is not represented as absent for claim 42, and the item is not represented as present for claim 45 . . . ."[6] Applicant has amended claims 42 and 45 by way of non-narrowing amendments for purposes of clarification, and is hopeful that the Examiner may now appreciate the patentability of these claims. In particular, amended claim 42 recites a method of reconciling an inventory list of items associated with RFID tags, comprising the steps of: (a) using an RFID reader to interrogate at least one RFID tag associated with an item; (b) determining whether the item is represented on the inventory list as being absent, and when the item is represented as being absent: (i) indicating to a user in real time that the inventory list incorrectly indicates that the item is absent; and (ii) enabling the user to correct the inventory list in real time by confirming that the item is present using a user interface associated with the RFID reader. Thus, claim 42 requires when an interrogated item is represented on the inventory list as being absent, but in reality the item is actually present, indicating this fact to the user and enabling the user to correct the inventory list in real time.

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[6] Office Action dated August 10, 2006, at page 5.

-20-

In a similar manner, amended claim 45 recites a method of reconciling an inventory list of items associated with RFID tags, comprising the steps of: (a) using an RFID reader to interrogate at least one RFID tag associated with an item; (b) determining whether an item represented on the inventory list as being present is among the items whose RFID tags were interrogated, and when the item is not among the items whose RFID tags were interrogated: (i) indicating to a user in real time that the inventory list incorrectly indicates that the item is present; and (ii) enabling the user to correct the inventory list in real time by confirming that the item is absent using a user interface associated with the RFID reader. Thus, claim 45 requires when an item is represented on the inventory list as being present, but in reality the item is actually is not among the items whose RFID tags were interrogated, indicating this fact to the user and enabling the user to correct the inventory list in real time.

Garber in view of Barritz fails to teach or suggest these features. In contrast, Barritz only addresses the situation of interrogating a tag and determining that the item associated with an interrogated tag is not listed in the database of known inventory items, and enabling the user to create a new inventory item. Neither of claims 42 or 45 are directed to updating an inventory with respect to new items. With respect to claim 42, the teaching of Barritz is not the same as determining whether an item is represented on the inventory list as being absent (i.e., that an entry for the item does exist in the inventory list and is expected to be absent), but the item is instead physically present. With respect to claim 45, the teaching of Barritz is not the same as determining whether an item is represented on the inventory list as being present (i.e., that an entry for the item does exist in the inventory list and is expected to be present), but the item is instead physically absent. Neither Garber nor Barritz, taken alone or in combination, provides any teaching or suggestion of such features.

Claims 48 and 95

In the Office Action, the Examiner appears not to have specifically addressed the limitations of independent claims 48 and 95. The Examiner merely generally stated that Garber teaches scanning a plurality of items having RFID elements to obtain information from those elements. The teachings of Garber are directed to scanning presumably ordered items to determine whether any of the items is actually out of order. For example, Garber et al. states: "The RFID device of the present invention could also be used to verify the order of materials on

-21-

Application Number 09/876,432
Responsive to Office Action mailed August 10, 2006

a shelf. . . . The device reads each item and indicates, to the operator, which items are not shelved in the correct order."[7] In contrast, Applicant's claim 48 requires interrogating RFID tags of items that are not currently located at their desired locations and not arranged or interrogated in an order associated with their desired physical locations in a storage area.

Moreover, claim 48 requires that the information obtained from the RFID tags is organized in an order in which the items are to be moved from their current location to the desired locations of the items in the physical storage area, and this organized information is presented to a user. As explained in the present application on pg. 9, these feature may be very useful in, for example, returning books to library shelves after use. Garber provides teaching of organizing information from RFID tags into an order in which the items are to be moved from their current locations to their desired locations in the physical storage area, thereby facilitating returning those items to the physical storage area. Instead, Garber merely provides an indication to the user of any item that is not in the algorithm order.[8] Thus, to the extent the system of Garber presents any information to the user, the system merely indicates any particular item that is out of order. Garber in view of Barritz makes no suggestion of presenting organized information in an order in which the items are to be moved to desired locations, as required by amended claim 48.

Similarly, with respect to amended independent claim 95, Garber in view of Barritz provides no teaching or suggestion of, with a portable RFID reader, obtaining a list of information related to RFID tags organized in the order in which the RFID tags were interrogated, and organizing the information in a different order with the portable RFID reader. The system of Garber et al. need not reorganize information obtained from the tags at all when determining whether a particular scanned items are in an algorithm order, and nothing in Garber suggests that any such reorganization is necessary. Barritz similarly provides no teaching sufficient of the features recited by claim 95.

Claim 102

In the Office Action, the Examiner rejected claim 102 under 35 U.S.C. 103(a) as being unpatentable over Garber in view of Barritz as applied to claim 97 above, and further in view of

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[7] Garber et al., col. 17, ll. 17–21 (emphasis added).
[8] See, e.g., Garber et al., col. 19, ll. 30–31.

-22-

Parulski et al. (US 5,633,678). Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention. Claim 102 is patentable for the same reasons stated above for independent claim 95; namely, because the Garber reference lacks the basic teachings attributed to it by the Examiner, and because one skilled in the art would have had no motivation to look from Garber to Barritz for any modifications. Moreover, Parulski et al. provides no teaching sufficient to cure the basic deficiencies already evident in Garber and Barritz.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 39–42, 45, 48 and 95–102 under 35 U.S.C. 103(a). Withdrawal of this rejection is requested.

Rejection for Obviousness-type Double Patenting:

The Examiner provisionally rejected claims 1, 3–8, 10–24 and 48–49 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 60 and 64-77 of copending Application No. 09/882,969. The Examiner provisionally rejected claims 32–37 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14–16 and 42 of copending Application No. 09/755,714.

Applicant notes the provisional status of these rejections. Accordingly, Applicant will address this issue if and when the rejection is formally applied.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

-23-

Application Number 09/876,432
Responsive to Office Action mailed August 10, 2006

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-24-